

REMARKS/ARGUMENTS

Status of the Claims

Before this Amendment, claims 30 – 34, 40, and 44 – 49 were present for examination. No claims are added, amended, or canceled. Therefore, claims 30 – 34, 40, and 44 – 49 are present for examination, and claims 30 and 40 are the independent claims. Claims 30-34, 40, 42, and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,169,894 B1 to McCormick et al. (“McCormick”) in view of the cited portions of U.S. Patent No. 6,246,430 to Peters et al. (“Peters”). For the reasons discussed below, Applicants respectfully request withdrawal of the rejection.

35 U.S.C. §103 Rejections

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. See, e.g., *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Office Action to demonstrate that all the claim elements are shown in the prior art. See MPEP §2143. However, as will be discussed below, the references cited by the Office Action and ordinary knowledge in the art fail to teach or suggest all the recitations of independent claims 30 and 40. Therefore, Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims.

Specifically, neither McCormick nor Peters can be relied upon to teach or suggest (1) “broadcasting the selected media program to the wireless handset over the wireless channel as a one-way phone call having no return audio path;” or (2) “establishing a return data-

command path over the wireless channel adapted to receive a media selection or a phone call from the wireless headset,” as recited in claim 30. Claim 40 includes similar recitations.

The Office Action suggests that McCormick discloses “broadcasting the selected media program to the wireless handset over the wireless channel as one-way phone call having no return audio path (muting the reverse voice channels during such broadcast, abstract).” Office Action, p. 3, ll. 12-14. However, the cited section of McCormick only discloses a local cell site muting a transmit (or reverse) voice channel of a particular mobile unit, which is different from “broadcasting the selected media program to the wireless handset over the wireless channel as a one-way phone call having no return audio path,” as generally recited in claims 30 and 40.

The McCormick system apparently requires muting of the reverse channel (and disabling of other call features of the mobile unit such as call waiting and other multi-party features) due to the fact that it provides a reverse channel that may be erroneously used by the mobile unit. On the other hand, the independent claims generally recite “broadcasting the selected media program to the wireless handset over the wireless channel as a one-way phone call having no return audio path,” and, therefore, there is no need to mute the reverse channel or to disable other features of a mobile unit, as in the McCormick system. *In fact, by providing a reverse channel, McCormick apparently creates a two-way audio path, which must be muted. As such, the cited portions of McCormick actually teach away from a one-way phone call having no return audio path*, as recited in claims 30 and 40.

Further, the Office Action admits that “McCormick did not disclose specifically establishing a return data-command path over the wireless channel adapted to receive a media selection or a phone call from the wireless handset [as recited in claims 30 and 40].” Office Action, p. 3, ll. 15-17. Instead, the Office Action relies on Peters as remedying this deficiency of McCormick. Id., ll. 18-20. However, the cited section of Peters only discloses transmitting a selection of numbers entered by a consumer over a signaling channel, specifying that the signaling channel is part of an ISDN based network interconnecting a customer premises equipment with a video server. *See* Peters, Fig. 1 and Col. 2, ll. 4-11.

It is well known in the art that ISDN is essentially a set of communications standards enabling *traditional telephone lines* to carry voice, digital network services, and video. Therefore, an ISDN based network does not deal with wireless channels and/or wireless handsets. As a matter of fact, Peters does not appear to disclose any use of wireless channels or wireless handsets at all, let alone establish a return data-command path over a *wireless channel* adapted to receive a media selection or a phone call from a *wireless handset*. As such, it is unreasonable to construe Peters as teaching or suggesting any type of functionality in the context of wireless channels or wireless handsets.

Additionally, even if, *arguendo*, the ISDN network functionality of Peters could be construed to apply in a wireless context, there is no teaching or motivation in Peters of *establishing* a return data-command path over a wireless channel. On the contrary, because an ISDN based network always includes a signaling channel (*see* Peters, Col. 2, ll. 10-15), there would be no need or motivation to establish a return data-command path when using such an ISDN based network. As such, it is unreasonable to construe Peters as teaching or suggesting “establishing a return data-command path over the wireless channel adapted to receive a media selection or a phone call from the wireless handset,” as generally recited in claims 30 and 40.

For at least these reasons, both of the cited references, McCormick and Peters, alone or in combination, fail to teach or suggest the recitations of claims 30 and 40. Further, the Office Action does not provide any teaching from other art or reason why these recitations would be within the knowledge of a person of ordinary skill in the art. As such, the combined teachings of the art cited by the Office Action fail to establish a *prima facie* case of obviousness as to the independent claims. Moreover, claims 31 – 34 and 44 – 49 are believed allowable at least for reasons of their dependence from allowable base claims. Applicants, therefore, respectfully request that the §103 rejections to all the claims be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Daniel J. Sherwinter/

Daniel J. Sherwinter

Reg. No. 61,751

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
D6S:s5k
62408145 v1